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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,211	01/28/2002	Satoru Funakoshi	7372/72577	6904

22242 7590 07/02/2004

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/056,211</p>	<p><b>Applicant(s)</b></p> <p>FUNAKOSHI, SATORU</p>	
	<p><b>Examiner</b></p> <p>Catherine Simone</p>	<p><b>Art Unit</b></p> <p>1772</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Withdrawn Rejections***

1. The 35 U.S.C. 102 rejection of claims 1, 2 and 6-8 as anticipated by Waragai et al. of record in the Final Office Action mailed 11/20/03, Pages 2-3, Paragraph #5 has been withdrawn due to the Applicants remarks filed 5/18/04.
2. The 35 U.S.C. 103 rejection of claims 3 and 4 over Waragai et al. of record in the Final Office Action mailed 11/20/03, Pages 3-4, Paragraph #7 has been withdrawn due to the Applicants remarks filed 5/18/04.
3. The 35 U.S.C. 103 rejection of claim 5 over Waragai et al. in view of Masubuchi et al. of record in the Final Office Action mailed 11/20/03, Pages 4-5, Paragraph #8 has been withdrawn due to the Applicants remarks filed 5/18/04.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitations “the ratio (R/L) of the curvature R of a joint between the projection and the substrate to the thickness L of the skin layer is from 3 to 50” in claim 1 and “said joint having a curvature R wherein the ratio of R/L is from 3 to 50” in claim 8 are deemed vague and indefinite. What are the values for the curvature and the thickness? Where do you get the curvature value and the thickness value from in order to get the ratio? Clarification is requested.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 2 and 5-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Masubuchi et al. (EP 0 925 895).

Regarding **claims 1** and **6-8**, Masubuchi et al. discloses an automotive interior part comprising a thermoplastic resin foam molding, the molding comprising a substrate having a bottom portion (Fig. 1, #5), a projection (see Fig. 1 shown below) projecting from the bottom portion, the substrate and the projection being formed as one piece during molding from the same material, wherein a joint is being defined by the projection relative to the substrate (see Fig. 1 shown below), the substrate including a skin layer (Fig. 1, #4; also see page 5, line 41) inherently having a thickness L and a foam layer (see page 4, lines 32-36) wherein both are the same material, the skin layer having no voids (see page 7, lines 20-23), the joint inherently having a curvature R wherein the ratio of R/L is inherently from 3 to 50. Regarding **claim 2**, the

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foam layer of the substrate inherently has a density of 0.7 g/cm<sup>3</sup> or less, since it is made up of the same material as that disclosed in the present invention. Regarding **claim 5**, the thermoplastic resin foam molding is a propylene-based resin whose Izod impact value at 23°C is 10 KJ/m<sup>2</sup> or more (see page 3, lines 16-18).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

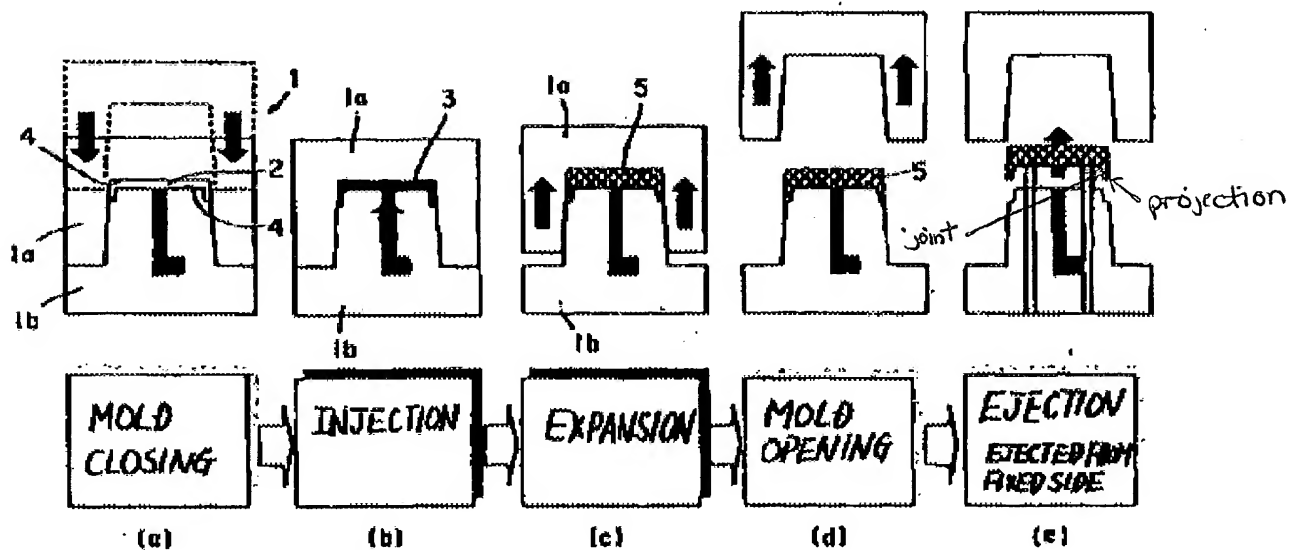
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Masubuchi et al. (EP 0 925 895).

Regarding **claims 3 and 4**, Masubuchi et al. discloses the claimed invention except for the joint between the substrate and projection having a foamed ratio of from 1 to 1.3 and the projection having an average foamed ratio of from 1 to 1.3 times. Although, Masubuchi et al. does teach in Fig. 1 a showing of a joint between the substrate and the projection having a foamed ratio and a projection having a foamed ratio. However, Masubuchi et al. fails to teach the specific claimed foamed ratio for the joint between the substrate and the projection and the specific claimed average foamed ratio for the projection. One of ordinary skill in the art would have recognized the foamed ratio for the joint between the substrate and the projection to be of from 1 to 1.3 times and the average foamed ratio for the projection to be of 1 to 1.3 times as shown by Fig. 1 of Masubuchi et al. Therefore, the one of ordinary skill in the art would have

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readily determined the foamed ratio of the joint between the substrate and the projection and the average foamed ratio of the projection through routine experimentation depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified in Masubuchi et al. the joint between the substrate and projection to have a foamed ratio of from 1 to 1.3 and the projection to have an average foamed ratio of from 1 to 1.3 times, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.



### *Response to Arguments*


10. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.


### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Catherine Simone  
Examiner  
Art Unit 1772  
June 30, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

6/30/04